UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,136	01/16/2001	Terry Tam	8673-112 (8061-567 SJP/K1	3423

22150	7590	02/07/2006	EXAMINER

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ART UNIT	PAPER NUMBER
2144	

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/761,136	TAM, TERRY
	Examiner	Art Unit	
	Yemane M. Gerezgiher	2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 December 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16,19 and 20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16,19 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   The request for continued examination received on 12/19/2005 has

been entered. Claim 18 is cancelled and Cliams1-16, 19 and 20 remain

pending in this application.

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefore, subject to the conditions and requirements of this title.

2.   Claims 1-16 and 19-20 are rejected under 35 U.S.C. 101 because the

claimed invention is directed to non-statutory subject matter.

Claim 1 Recite: A terminal for communicating over a computer-network
using a message, wherein the terminal encodes the message and said
message comprises,

a Protocol Data Unit encoded in accordance with a Simple
Supplementary Services Protocol (SSSP) and carried via messages over an
existing protocol for network communications, comprising:

an identifier field for identifying different functionally based

supplementary services;

an end tag field for denoting message endings; and

a parameters extensions field separating said identifier field and said end

tag field.

A PDU comprising **a collection of fields** including *an identifier field*

separating different functionally based supplementary services; an end tag field denoting message endings; and a parameters extensions field separating said identifier field and said end tag field, is merely **a collection data fields in a data structure**, which is minimally an **abstract** idea, **which has no tangible result.** There must be more than just a thought or a computation in order to prove a tangible result.

The PDU comprising identifier fields identifying supplementary services ... and further detailing and limiting depending claims 2-16 fall under the same category. According to the patent law, claimed invention, as a whole must produce a "useful, concrete and tangible" result to have a practical application resulting in a useful, concrete, and tangible result where usefulness under patent eligibility requires considerable functionality present to complete useful outcome aspect of the practical application. See MPEP 2106 (Patentable Subject Matter - Computer-Related Inventions). The presented claims in this application failed to satisfy the requirement described above.

Claim19, has substantially the same limitations as in claim 1, therefore the claims are rejected with the same rationale. Even though claim 19 calls for a method, the claims are both directed to a non-statutory subject matter, because *an identifier field separating different functionally based supplementary services; an end tag field denoting message endings; and a parameters extensions field separating said identifier field and said end tag field,* is merely **a collection of identifiers in a data structure**, which is

minimally an **abstract** idea, lacking a tangible result. Thus, the proposed

amendments do not cure the deficiency (non-statutory) for the reasons

described above and in the rejection of the last office action.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a whole
> would have been obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains. Patentability shall not be negatived by
> the manner in which the invention was made.

4.   Claims 1-16, 18, 19 and 20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over <u>Korpi</u> et al. (U.S. Patent Number 6,621,814) in view of what

would have been obvious to one of ordinary skill in the art at the time the

invention was made.

Korpi disclosed a method and apparatus for transmitting voice data in

data packets with additional supplementary services (See Title). <u>Korpi</u>

addressed the drawback of the standards that are approved very little by little

by the ITU for additional supplementary services taking a long time before such

standards are defined (See Column 2, Lines 30-44). <u>Korpi</u> disclosed a method

off encoding additional supplementary services in a fashion compatible with

the existing protocol of transmitting the existing standard supplementary

services. See Column 3, Lines 27-62. Korpi taught that the ITU-T Standard

H.323 allowing an expansion by new signaling protocol utilizing additional

supplementary services where the protocol used is the existing H.323 protocol.

See Column 5, Lines 40-49 and Column 1, Line 22 through Column 12, Line

16. Korpiu substantially disclosed the invention as claimed. However, Korpi

was silent about the specifics of the PDUs encoding including identifier fields

identifying functionally different supplementary service, the use of

alphanumeric string encoding, the use of a comma and/or an asterisk as a

ParameterSeperator, a protocol tag, the limited size of the characters used to

describe multiple data fields.

PDU is commonly defined as "*a message of a given protocol comprising*

payload and protocol-specific control information, typically contained in a header.

PDUs pass over the protocol interfaces which exist between the layers of

protocols (per OSI model)." Korpiu taught a method and apparatus of providing

additional supplementary services that are compatible with the existing

H.450.x standards. Since the teachings of Korpiu disclosed a method of

providing additional supplementary services, the use of plurality of parameters

was inherently disclosed. Further, since the disclosed teaching deals with the

pluralities of parameters or the data/identifier fields the use of some parameter

separator was inherent. Accordingly, the use of a "comma", "asterisk" as a

parameter separator, limiting the size of the string or character to one or more

in order to describe the message type and generally to define different sets of

fields in encoding a PDU is an arbitrary preference which does not change the end-result of the invention as claimed.

An artisan working with the invention of <u>Korpiu</u> related to additional supplementary services that are compatible with the existing protocol would have realized that the implementation (reduction to practice) step would require an arbitrarily syntax selection, alphanumeric encoding, and selection of arbitrary characters to separate parameters or to indicate a message type and describe fields of data in the PDU. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention to make arbitrary choices of alphanumeric encoding and selection of arbitrary characters and have modified the teachings of <u>Korpiu</u> related providing additional supplementary services in the H.323 systems in order to distinguish the added supplementary services from the existing standard H.450.x.

Response to Arguments

5.   Applicant's arguments filed 05/31/2005 have been fully considered but they are not persuasive.

6.   The inventive entity argues that the teachings of <u>Korpiu</u> failed to include "an identifier field for identifying different functionally based supplementary services or providing within said PDU an identifier field for identifying different functionally based supplementary services" **(Applicant's Remark on Page 8, Lines 15-19).**

Examiner respectfully disagrees with that contention for at least the following reasons:

First of all, it is apparent that <u>Korpiu</u> taught a method and apparatus of providing additional supplementary services that are compatible with the existing H.450.x standards in the H.323 systems (see Title and Column 3, Line 6 through Column 4, Lines 4). Furthermore <u>Korpiu</u> addressed that the H.323 protocol allowing expansion of new signaling of that are directed to the utilization of additional supplementary service or tunneling (Column 5, Lines 41-49) and "upon use of the additional supplementary service the voice transmission unit, the signaling unit is driven such that signaling commands are sent into the data transmission **that indicate that the additional supplementary service is to be used**" (Column 6, Lines 54-59).

By definition, tunneling is the act of encapsulating one communications protocol within another and more specifically, a tunneling is "A method of transmission over internetworks based on differing protocols. In tunneling, a packet **based on one protocol is wrapped, or encapsulated, in a second packet based on whatever differing protocol is needed in order for it to travel over an intermediary network**. In effect, the second wrapper "insulates" the original packet and creates the illusion of a tunnel through which the wrapped packet travels across the intermediary network. In real-life terms, tunneling is comparable to "encapsulating" a present (the original packet) in a box (the secondary wrapper) for delivery through the postal

system" (source: http://www.microsoft.com/technet/prodtechnol/visio/visio2002/plan/glossary.mspx).

Having that fact, in the functional step of tunneling, it is inherent that there

are some identifiers in the data fields of the packet that must distinguish the

encapsulation of one message (PDU) of one protocol from or within another

message encoded in a different protocol, where in this case identifies

functionally different (supplementary services other than the standard H.450.x

supplementary services). Thus, the rejection applied to the claims is

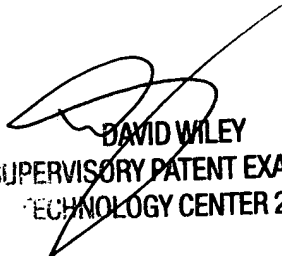maintained as a proper rejection.

Conclusion

2.   Any inquiry concerning this communication or earlier communications

from the examiner should be directed to Yemane M. Gerezgiher whose

telephone number is (571) 272-3927. The examiner can normally be reached

on 9:00 AM - 6:00 PM Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, David Wiley can be reached at (571) 272-3923. The fax

phone number for the organization where this application or proceeding is

assigned is 703-872-9306.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

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http://pair-direct.uspto.gov. Should you have questions on access to the

Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-

9197 (toll-free).

Yemane M. Gerezgiher
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